

### **REMARKS**

The undersigned appreciates the courtesy and helpful comments extended by the Examiner during recent telephone discussions.

Claims 19-35 have been cancelled without prejudice, and claims 36-40 have been added. No new matter has been added by virtue of the amendments. For instance, support for the new claims appears e.g. in the original claims of the application.

Under separate cover, Applicants will submit a 1449 form listing documents considered by the Examiner as noted at page 4 of the Office Action as well as an amendment of the specification to include sequence identifiers as recommended at page 4 of the Office Action.

Claims 22-30 were objected to under Rule 75(c) for improper form (multiply dependent claims), i.e. a non-substantive matter.

The new claims have proper dependency format. It is thus believed the objection is moot.

Claims 19-21 were rejected under 35 U.S.C. 101 as encompassing products of nature.

The pending claims recite "isolated". Therefore, it is believed the rejection is obviated.

Claims 19-21 were rejected under 35 U.S.C. 112, first paragraph on grounds of non-enablement.

Claims 19-21 were further rejected under 35 U.S.C. 112, first paragraph. As grounds for the rejection, the following is stated at page 9 of the Office Action:

Absent a written description disclosing a representative number of the species as claimed in claims 19-21 of the specification fails to show that Applicants was, in fact “in possession of the claimed invention” at the time the application for patent was filed.

For the sake of brevity, the two Section 112, first paragraph rejections are addressed in combination. Each rejection is traversed.

The present application fully satisfies the requirements of 35 U.S.C. 112, including the requirements of Section 112, first paragraph.

Thus, for instance, suitable nucleic acid molecules are disclosed at length at pages 8-120. Methods for preparing and identifying such molecules is disclosed for instances at pages 10 through 16 of the application. **The application continues to actually exemplify many suitable nucleic acid molecules in the examples.**

From such extensive disclosure, the skilled worker can readily identify additional, specific suitable nucleic acid molecules. Indeed, candidate molecules could be simply tested according to Example 11 (Binding inhibition experiment) as set forth on page 26 of the application.

Moreover, no substantiating reasons have been advanced as to why one skilled in the art utilize the claimed invention. Indeed, the discussion above makes clear that one skilled in the art could readily practice the claimed invention in view of Applicants’ disclosure.

Respectfully, such a rejection, lacking any supporting evidence or other substantiating grounds, is simply not proper. Thus, for example, MPEP §2164.04 states the following (quoting *In re Marzocchi*, 169 USPQ 367):

[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

Accordingly, reconsideration and withdrawal of the rejections are requested.

Claims 19 and 21 were rejected under 35 U.S.C. 102 over Avruch et al. (U.S. Patent 5582995).

Claim 19 was rejected under 35 U.S.C. 102 over Freed et al. (U.S. Patent 5,597,719).

Claim 19 was rejected under 35 U.S.C. 102 over Vogelstein et al. (U.S. Patent 5,910,407). The rejection is traversed.

For the sake of brevity, the above several Section 102 rejections are addressed in combination. Each of the rejections is traversed.

Applicants' independent claim 36 (the only pending independent claim) calls for:

An isolated RNA which specifically binds to Raf-1 protein, wherein the RNA comprises at least one sequence selected from the group consisting of SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5, SEQ ID NO:6, SEQ ID NO:7, SEQ ID NO:8, SEQ ID NO:25, SEQ ID NO:26, SEQ ID NO:27, SEQ ID NO:28, and a sequence of 81-99 nucleotides which is obtained through the decrease of one base each from the 3' end of SEQ NO:25.

None of the cited documents disclose such isolated RNA. Thus, for instance, Avrush merely reports certain DNA encoding Ras protein or Raf-1 protein. The disclosure at column 6, lines 5-13 of Avrush is directed to a polypeptide, not nucleic acid.

Freed also is deficient and merely reports a nucleotide sequence that encodes Raf-1 protein itself or 14-3-3 protein. Nowhere does Freed disclose the sequences recited in Applicants' independent claim 36.

The Vogelstein citation is also clearly distinct and merely reports a PCR primer to amplify a polynucleotide of K-ras from a stool specimen. Nowhere does Vogelstein disclose the sequences recited in Applicants' independent claim 36.

In view thereof, reconsideration and withdrawal of the rejections are requested. See, for instance, See *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) (“[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.”).

Claims 19-21 were rejected under 35 U.S.C. 102 over Kimoto et al. (FEBS Letter 1998).

Claims 19-21 were rejected under 35 U.S.C. 102(e) over Sherman et al. (US 2003/0170751).

These two rejections over Kimoto et al. and Sherman et al. are addressed in combination.

Applicants submit herewith certified English language translations of the priority cases, Japanese Patent Application No. 10-242596/1998 filed with the Japanese Patent Office on August 14, 1998, and Japanese Patent Application No. 10-333284/1998 filed with the Japanese Patent Office on November 24, 1998.

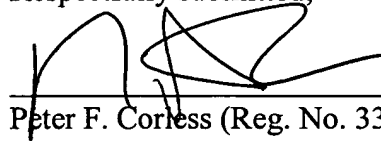
Thus, Kimoto et al. and Sherman et al. and Sherman et al. do not have sufficiently early dates to be cited against the present application.

S. Yokoyama et al.  
U.S.S.N. 09/529,397  
Page 7

In view thereof, reconsideration and withdrawal of the rejections are requested.

It is believed the application is in condition for immediate allowance, which  
action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Peter F. Corless', written over a horizontal line.

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